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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/657,105

09/09/2003

Toshiyuki Nakata

YMOR : 295

9858

6160

7590

03/08/2005

PARKHURST & WENDEL, L.L.P.

1421 PRINCE STREET

SUITE 210

ALEXANDRIA, VA 22314-2805

EXAMINER

DONOVAN, LINCOLN D

ART UNIT

PAPER NUMBER

2832

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/657,105	<b>Applicant(s)</b> NAKATA ET AL.	
	<b>Examiner</b> Lincoln Donovan	<b>Art Unit</b> 2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 18-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01-20-04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 1-17 in the reply filed on 10-08-04 is acknowledged. The traversal is on the ground(s) that a complete search for the subject matter of the elected claims should encompass a thorough and complete search for the subject matter of the non-elected claims. This is not found persuasive because the non-elected claims are drawn to a method of manufacturing requiring searching in an art different from that of the elected article.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant should clarify the specific location at which the approximate 180° angle intended to be formed. The specific locations of each of the center lines and their relationship with each other to form the angle is unclear.

Regarding claim 5, in lines 1-2, there is no antecedent basis for "the groove." In line 4, there is no antecedent basis for "the ring connecting section."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Soto et al. [US 6,222,437].

Regarding claims 1 and 4. Soto et al. discloses a coil component [51] comprising:

- a plurality of ring sections [18, 20, 22, 24], each comprising an arc-shaped portion having a slit, formed of a metallic flat plate [10];
- a plurality of ring connecting sections [26, 28, 30, 32, 36], formed at the end sections of the arc-shaped portions of the ring sections, formed with a groove [36, 38, 40, 42, 44 and 46] therein;
- a coil section [51] having a through-hole [20] formed of the ring sections being bent at the ring connecting sections and placed one on top of another [figure 3];
- terminals [52, 54] connected to the coil section formed at end sections where the ring sections are not connected to each other; and
- a package member [88, 90] covering the coil section and having the terminals projecting therefrom [figure 7].

Regarding claim 5, Soto et al. discloses the grooves being formed in a direction perpendicular to a center line connecting centers of the ring sections adjacent to each other and connected by the ring connecting sections [figures 1 and 3].

Regarding claim 6, Soto et al. discloses a projection extending toward the slit formed at each end section of the arc-shaped portion of the ring section where the ring sections are connected to each other [figures 1 and 3].

Regarding claim 7, Soto et al. discloses each of the ring sections having substantially equal outside diameters [figures 1 and 3].

Regarding claim 9, Soto et al. discloses the terminals being stepped so as to be adjacent to each other when the ring sections are placed on top of another [figures 1 and 3].

Regarding claim 11, Soto et al. discloses the coil section being formed of four ring sections connected together [figure 1].

Regarding claim 12, Soto et al. discloses a length of the ring connecting section formed at one end section of the arc-shaped portion of the ring section being greater than a length of the ring connecting section formed at the other end section [figure 1].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 8, 13 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soto et al.

Regarding claims 2-3, Soto et al. disclose everything claimed except the specific orientation of the terminals.

The specific orientation of the terminals would have been an obvious design consideration based on the specific application and mounting technique used.

Regarding claim 8, Soto et al. disclose everything claimed except the peripheral edge portions of the ring sections being chamfered.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to chamfer the edges of the ring sections in order to reduce chaffing during manufacture.

Regarding claim 13, Soto et al. disclose everything claimed except the specific shape of the package member. It would have been an obvious matter of design choice to use alternate shapes for the package member, since such a modification would have involved a mere change in the shaped of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 14-16, Soto et al. disclose everything claimed except the specific manufacturing process of the coil component. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the **product** itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soto et al. as applied to claim 1 above, and further in view of Yerman et al. [US 5,017,902].

Yerman et al. discloses a flat layered coil formed of a plurality of rings with an dielectric coating applied thereto [abstract].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an insulating layer on the rings of Soto et al., as suggested by Yerman et al., for the purpose of providing insulation between the coil turns.

***Allowable Subject Matter***

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

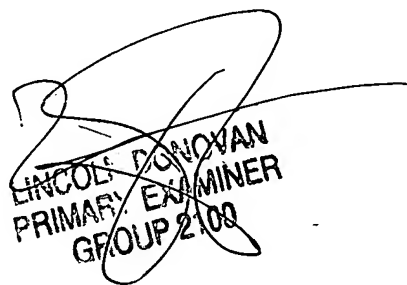
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lincoln Donovan whose telephone number is 571-272-1988. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2832

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ldd

  
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